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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
GENE EGGLESTON ET AL.	: EXAMINER: WINDER, PATRICE
SERIAL NO: 09/095,325	:
FILED: JUNE 10, 1998	: GROUP ART UNIT: 2152
FOR: METHOD AND APPARATUS FOR RATE GOVERNING COMMUNICATIONS	:

37 CFR 1.131 DECLARATION OF RICHARD KREBS

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

(1) I was one of the founding members of the AirMobile® group of Motorola, and I was one of the alpha testers of the first product.

(2) I am a named co-inventor of application serial No. 08/574,528 (abandoned) (hereinafter referred to as "the '528 application"), which is a parent of the above-identified application. The other named inventors of the '528 application were Gene Eggleston and Mitch Hansen.

(3) The '528 application was a continuation-in-part ("CIP") application of application serial No. 08/557,657 (hereinafter referred to as "the '657 application"). The '657 application matured into U.S. patent No. 5,771,353.

(4) It is my understanding that a CIP application reflects that additional disclosure was added to the '657 application when the '528 application was filed. In this case, the additional disclosure was directed to rate governing of data communicated between the mobile client and the AirMobile® Communication Server. My contribution to the invention

disclosed by the '528 application was the additional disclosure pertaining to the rate governing.

(5) I have reviewed claims 33-65 of the above-identified application (copies of those claims are set forth in the attached appendix). In particular, I have reviewed independent claims 33, 54, 55, 56, 60, 64, and 65. Each of those claims recites what is referred to as the transparency feature. The transparency feature was first disclosed in the '657 application.

(6) Claim 33 recites the transparency feature (see the step in bold):

> 33. A method of forwarding messages between a host system and a mobile client, comprising the steps of:
>
> establishing a session based on loaded parameters at the host system;
>
> maintaining the session at the host system and querying the host system;
>
> receiving messages directed to a first address at the host system from a plurality of message senders;
>
> in response to a query, continuously forwarding the messages from the host system to the mobile client;
>
> receiving the messages at the mobile client;
>
> generating reply messages at the mobile client to be sent to the plurality of message senders and transmitting the reply messages to the host system;
>
> **receiving the reply messages at the host system and configuring the reply messages such that it will appear to the plurality of message senders that the reply messages originated at the first address associated with the host system**; and
>
> transmitting the reply messages from the host system to the plurality of message senders.

(7) Similarly, claims 54, 55, 60, and 64 recite a transparency step. Claim 54 recites the step of "receiving reply messages from the mobile client at the host system and configuring the reply messages such that it will appear to the plurality of message senders that the reply messages originated at the first address associated with the host system ...." Claim 55 recites the step of receiving the reply messages at the host system and configuring

the reply messages such that it will appear to the plurality of message senders that the reply messages originated at the first address associated with the host system ...." Both of these steps recite what we call the transparency feature.

(8) Claim 60 recites the step of "configuring the received message such that the received message appears to the message recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile client or host system appear to originate at the message sender's first address ...." This step also recites the transparency feature.

(9) Finally, claim 64 recites the steps of "configuring the outgoing messages so that the outgoing messages appear as if they were generated at either the mobile client or the host system; and transmitting the outgoing messages from the host system to message recipients." Again, this step recites the transparency feature.

(10) Hence, each of the active independent method claims defines a transparency step.

(11) Independent claim 56 is directed to a computer system for forwarding messages from a mobile client. Claim 56 recites the transparency feature (see the feature in bold):

> A computer system for forwarding messages from a mobile client comprising:
>
> a host system capable of sending and receiving messages, wherein a message sender's email address is associated with the host system;
>
> a forwarding component operable with the host system that upon receiving a message generated at the mobile client, by a message sender destined for a message recipient, configures the received message, prior to forwarding to the message recipient, **such that the received message appears**

to the message recipient as if the received message originated at the sender's email address associated with the host system, thereby allowing messages generated at either the mobile client or host system to appear to originate at the sender's email address associated with the host system.

(12) Claim 65 is directed to a computer readable medium with software instructions for enabling a method of forwarding messages including the steps of "configuring the received message such that the received message appears as if it were generated at either the mobile client or host system; and forwarding the configured received message to the message recipient." Thus, the software instructions embodied on a computer readable medium (claim 65) enable a method including a transparency step.

(13) I remember that, prior to June 07, 1995, Motorola had tested successfully in this country the invention as described and claimed in the subject application as evidenced by the following paragraphs.

(14) Prior to June 07, 1995, Motorola prepared software embodying the transparency feature of the invention. Attached hereto are copies of a slightly modified version of a PowerPoint® presentation that I was told were used by Mr. Sonnentag during an examiner interview on June 5, 2007. Screenshots of the directory of the software modules reflecting that the software was completed prior to June 07, 1995 are attached hereto as Exhibit A.

(15) The first screen shot (page 5 of the PowerPoint® presentation, not including the title page) is of the AirMobile® client software directory. Each of those files has dates prior to June 07, 1995 with the exception of three files.

(16) The default.dbf file has an October 10, 2006 date because, when the AirMobile® client software is first installed on a computer, the default.dbf is created and Windows® automatically adds the date stamp. In this case, I understand that Mr. Eggleston

installed the client software on October 10, 2006.

(17) The profile.dbf and RFMLIB.INI files have May 16, 2007 dates, respectively, because the AirMobile® client software modifies this file when the software is run.

(18) The second screen shot (page 6 of the PowerPoint® presentation, not including the title page) is of the AirMobile® communication server software directory. Each of those files has a date prior to June 07, 1995 with the exception of the same three files of the client software directory default.dbf, profile.dbf, and RFMBLIB.INI which have dates subsequent to June 07, 1995. The profile-old.dbf file was originally named profile.dbf and was modified by the AirMobile® client software on May 14, 1995. I understand that Mr. Eggleston manually renamed the file profile-old.dbf.

(19) The CDRVDLL.DLL file of the first and second screen shots is a dynamic link library file which enabled a radio to be connected to the mobile client's serial port. The CDRVDLL.DLL file was obtained as a part of a third party software license.

(20) The PKWDCL.DLL file of the first and second screen shots is also a dynamic link library file which enabled the mobile communications to be encrypted. The PKWDCL.DLL file was also obtained as a part of a third party software license.

(21) Additionally, annotated screen shots of the GUI of the pre Jun 07, 1995 software reflecting that the subject claims had been reduced to practice are attached hereto as a part of the PowerPoint® presentation. The following is a claim chart correlating the screen shots with claim 65.

Applicants' Claim 65	**Screen Shots**
A computer readable medium encoded with software instructions for enabling a method of forwarding messages generated at a mobile client by a message sender destined for a message recipient, the method comprising the steps of:	As reflected by the screen shots of the two directories, pages 5 and 6, the software instructions for enabling the method of forwarding messages was encoded on a computer readable medium.
receiving a message, generated at the	See the screenshot entitled "Mitch's

mobile client by the message sender destined for the message recipient, at a forwarding component associated with a host system,	reply message as received by Gene" which reflects that Mitch Hansen sent a reply message to Gene Eggleston indicating "Ok, I'll be there." That message was forwarded to the AirMobile Communication Server from Mitch's mobile client.
wherein messages generated at the host system by the message sender use a first address;	The first address is "Mitch Hansen at postoffice". See e.g., the AirMobile Client screenshot.
configuring the received message such that the received message appears as if it were generated at either the mobile client or host system; and	The "AirMobile Client" and "AirMobile Server" screenshots illustrate the manner in which the first address "Mitch Hansen at postoffice" maps to the local radio ID. The mapping and the communication between the AirMobile Server and the cc:Mail Server "post office" enables the Communication Server to configure the received message such that the received message appears as if it were generated at either the mobile client or host system.
forwarding the configured received message to the message recipient.	The configured email is forwarded to "Gene Eggleston." See the "AirMobile Message Flow Sequence Chart (Mobile to LAN)" screenshot.

(22) The AirMobile® software was successfully run prior to June 07, 1995. Thus, Motorola successfully performed the steps recited in claims 33, 54, 55, 60, and 64.

(23) Motorola ran the software using a communication server, a host post office, and a mobile client prior to June 07, 1995. Consequently, Motorola verified the functionality of the computer system verified in claim 56.

(24) In signing this declaration, I recognize that the declaration may be filed as evidence in a contested case before the Board of Patent Appeals and Interference of the United States Patent and Trademark Office. I also recognize that I may be subject to cross examination in the case and that cross examination will take place within the United States. If cross examination is required of me, I will appear for cross examination within the United

States during the time allotted for cross examination.

(25) I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Richard C. Krebs — February 15, 2008

Richard C. Krebs — Date

Richard C. Rubs

Appendix

Claims

33. A method of forwarding messages between a host system and a mobile client, comprising the steps of:

establishing a session based on loaded parameters at the host system;

maintaining the session at the host system and querying the host system;

receiving messages directed to a first address at the host system from a plurality of message senders;

in response to a query, continuously forwarding the messages from the host system to the mobile client;

receiving the messages at the mobile client;

generating reply messages at the mobile client to be sent to the plurality of message senders and transmitting the reply messages to the host system;

receiving the reply messages at the host system and configuring the reply messages such that it will appear to the plurality of message senders that the reply messages originated at the first address associated with the host system; and

transmitting the reply messages from the host system to the plurality of message senders.

34. The method of claim 33, further comprising the step of:

storing information regarding the configuration of the mobile client at the host system.

35. The method of claim 34, wherein the configuration information stored at the host include:

(A) the network address of the mobile client; and

(B) an indication of the types of message attachments that the mobile client will receive and process.

36. The method of claim 35, wherein the configuration information further includes:

(C) an indication of the protocol of the mobile client.

37. The method of claim 35, further comprising the steps of:

for each message to be forwarded, the host system determining whether the message includes an attachment, and if so then determining the type of attachment;

accessing the stored configuration information at the host system to determine whether the mobile client will receive and process attachments of the determined type; and

if so, then forwarding the attachments to the mobile client.

38. The method of claim 37, wherein the type of attachment is a sound file.

39. The method of claim 33, wherein the received messages are addressed using a sender address and a receiver address, the method further comprising the steps of:

determining whether the receiver address is associated with the mobile client;

if the receiver address is associated with the mobile client, then determining a network address of the mobile client and packetizing the messages using the receiver address and the network address of the mobile client; and

after receiving the forwarded messages at the wireless subscriber unit, displaying the messages at the mobile client using the sender address and the receiver address, so that it appears as though the mobile client is the host system.

40. The method of claim 33, wherein the parameters of the established session at the host system include external events, internal events, or networked events.

41. The method of claim 40, wherein the external event is a registration message from the mobile client.

42. The method of claim 40, wherein the internal event is an execution of control messages.

43. The method of claim 40, wherein the internal event is an execution of programs.

44. The method of claim 40, wherein the internal event is a timer operation.

45. The method of claim 40, wherein the networked events include messages to begin forwarding from computer systems other than the mobile client, which are connected to the host system via a wired network.

46. The method of claim 33, wherein the mobile client is a mobile station.

47. The method of claim 33, wherein the mobile client is a device equipped to receive both voice and non-voice data messages.

48. The method of claim 33, wherein the host system includes a client profile database limiting the forwarding step to forwarding only those messages that are transmitted to the host system from a sender stored in the database.

49. The method of claim 48, wherein a user can add and subtract senders from the database.

50. The method of claim 49, wherein the user can add and subtract senders from the database by configuring the host system.

51. The method of claim 49, wherein the user can add and subtract senders from the database by transmitting a command message from the mobile client to the host system.

52. The method of claim 48, wherein an active client profile database is activated and deactivated at the host.

53. The method of claim 48, wherein an active client profile database is activated and deactivated from the mobile client.

54. A message forwarding method operating at a host system, comprising the steps of:

associating a first address with the host system;

establishing a session with the host system based on loaded parameters;

maintaining the session at the host system and querying the host system;

receiving messages at the host system from a plurality of message senders;

in response to a query, continuously forwarding the received messages from the host system to a mobile client associated with the host system;

receiving reply messages from the mobile client at the host system and configuring the reply messages such that it will appear to the plurality of message senders that the reply

messages originated at the first address associated with the host system; and

transmitting the configured reply messages from the host system to the plurality of message senders.

55. A message forwarding method, comprising the steps of:

establishing a session with the host system based on loaded parameters;

maintaining the session with the host system and querying the host system;

receiving messages at the host system from a plurality of message senders;

in response to a query, continuously forwarding the received messages from the host system to a mobile client associated with the host system, wherein a first email address for the user of the mobile client is associated with the host system;

receiving the forwarded messages at the mobile client;

generating reply messages at the mobile client;

transmitting the reply messages from the mobile client to the host system;

receiving the reply messages at the host system and configuring the reply messages such that it will appear to the plurality of message senders that the reply messages originated at the first address associated with the host system; and

transmitting the configured reply messages from the host system to the plurality of message senders.

56. A computer system for forwarding messages from a mobile client comprising:

a host system capable of sending and receiving messages, wherein a message sender's email address is associated with the host system;

a forwarding component operable with the host system that upon receiving a message generated at the mobile client, by a message sender destined for a message recipient,

configures the received message, prior to forwarding to the message recipient, such that the received message appears to the message recipient as if the received message originated at the sender's email address associated with the host system, thereby allowing messages generated at either the mobile client or host system to appear to originate at the sender's email address associated with the host system.

57. A computer system as claimed in claim 56, wherein an email address field in the configured received message is the message sender's email address associated with the host system.

58. A computer system as claimed in claim 57, wherein a reply-to email address field in the configured received message is the message sender's email address associated with the host system.

59. A computer system as claimed in claim 58, further comprising a code added to the configured received message to make an indication to the message recipient.

60. A method for forwarding messages generated at a mobile client by a message sender destined for a message recipient, comprising the steps of:

receiving a message, generated at the mobile client by the message sender destined for the message recipient, at a forwarding component associated with a host system, wherein messages generated at the host system by the message sender use a first address;

configuring the received message such that the received message appears to the message recipient as if the received message originated at the sender's first address, wherein messages generated at either the mobile client or host system appear to originate at the

message sender's first address; and

forwarding the configured received message to the message recipient.

61. A method as claimed in claim 60, wherein the message sender's first address is an email address associated with the host system.

62. A method as claimed in claim 61, wherein the configuring step ensures an address field in the configured received message is the message sender's email address associated with the host system.

63. A method as claimed in claim 62, wherein the configuring step ensures a reply-to email address field in the configured received message is the message sender's email address associated with the host system.

64. A method for forwarding messages between a host system and a mobile client, comprising the steps of:

establishing a session with the host system based on loaded parameters;

maintaining the session with the host system and querying the host system;

receiving incoming messages directed to a first address at the host system from a plurality of message senders, wherein the first address is associated with messages generated at the host system by a user of the mobile client;

in response to a query, continuously forwarding the incoming messages from the host system to the mobile client;

receiving outgoing messages generated at the mobile client at the host system;

configuring the outgoing messages so that the outgoing messages appear as if they

were generated at either the mobile client or the host system; and

transmitting the outgoing messages from the host system to message recipients.

65. A computer readable medium encoded with software instructions for enabling a method of forwarding messages generated at a mobile client by a message sender destined for a message recipient, the method comprising the steps of:

receiving a message, generated at the mobile client by the message sender destined for the message recipient, at a forwarding component associated with a host system, wherein messages generated at the host system by the message sender use a first address;

configuring the received message such that the received message appears as if it were generated at either the mobile client or host system; and

forwarding the configured received message to the message recipient.

66. The method of claim 60, further comprising the steps of:

establishing a session with the host system based on loaded parameters;

maintaining the session with the host system and querying the host system; and

continuously forwarding messages received at the host system to the mobile client.

67. The method of claim 66, wherein the session is an execution of programs.

68. The method of claim 66, further comprising the steps of:

loading parameters at the host system; and

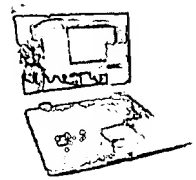
filtering received messages at the host system using one or more message filter prior to forwarding messages to the mobile client.

Exhibit A

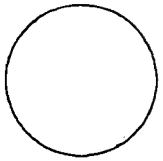
AirMobile Overview

Gene Eggleston

AirMobile Message Flow Sequence Chart (Mobile to LAN)



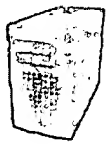
cc:Mail Mobile Client
"Mitch Hansen at postoffice"



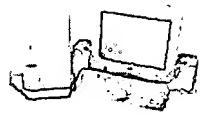
AirMobile Client
"2147651852"

Wireless Network

AirMobile Comm Svr
"2147651862"



cc:Mail Server
"postoffice"



Cc:Mail LAN Client
"Gene Eggleston at postoffice"

1. Send email
From: Mitch Hansen at postoffice
To: Gene Eggleston at postoffice

*** SEND STARTED ***
From: Mitch Hansen@2147651852;
To: Gene Eggleston@2147651862;
Subject: Re: Important Meeting;
Type: ccMail Msg; MsgID 1902;

*** SEND COMPLETED ***
From: Mitch Hansen@2147651852;
To: Gene Eggleston@2147651862;
Subject: Re: Important Meeting;
Type: ccMail Msg; MsgID 1902;

2.

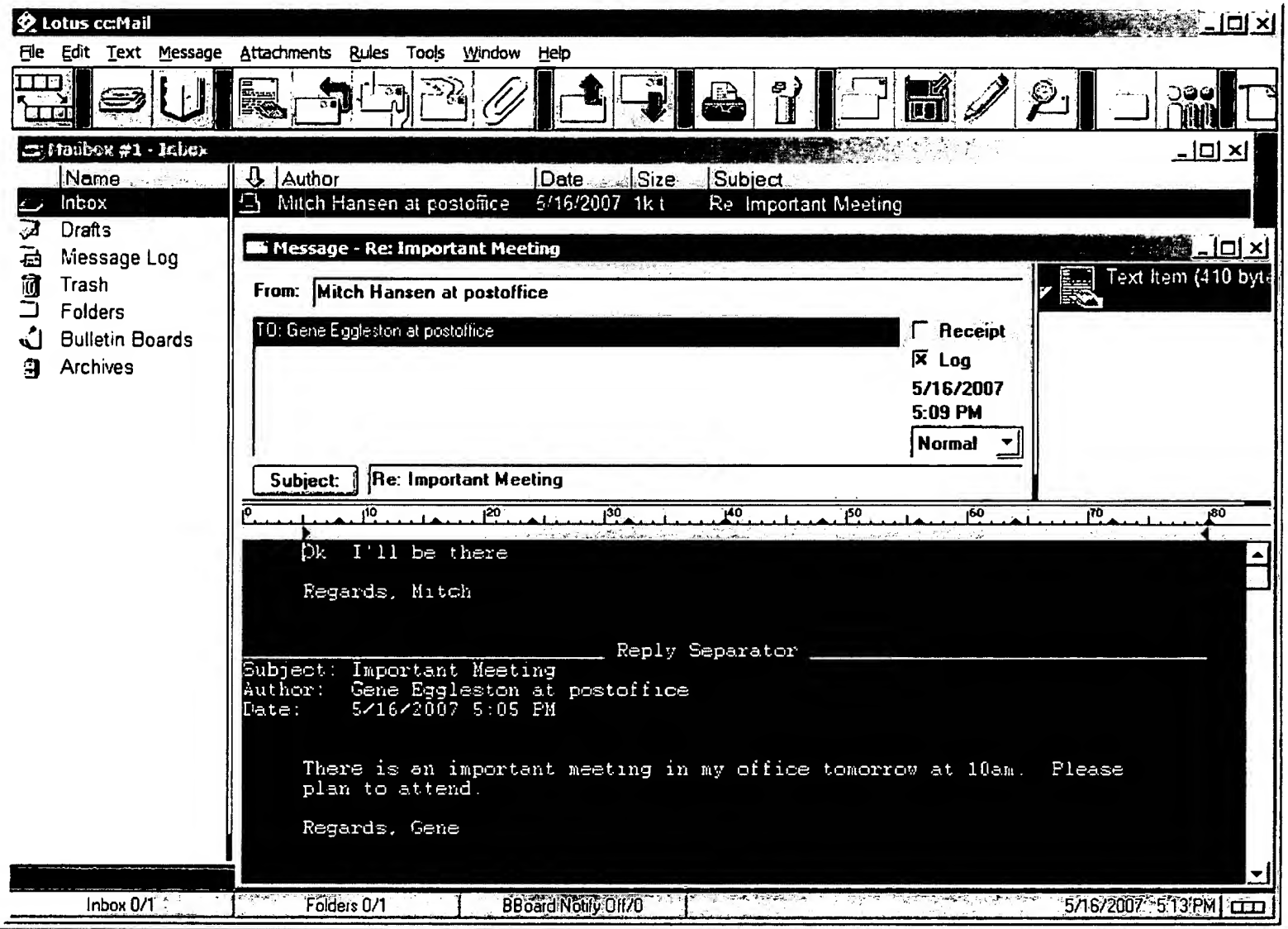
3. Receive email
From: Mitch Hansen at postoffice
To: Gene Eggleston at postoffice

4. Receive email
From: Mitch Hansen at postoffice
To: Gene Eggleston at postoffice

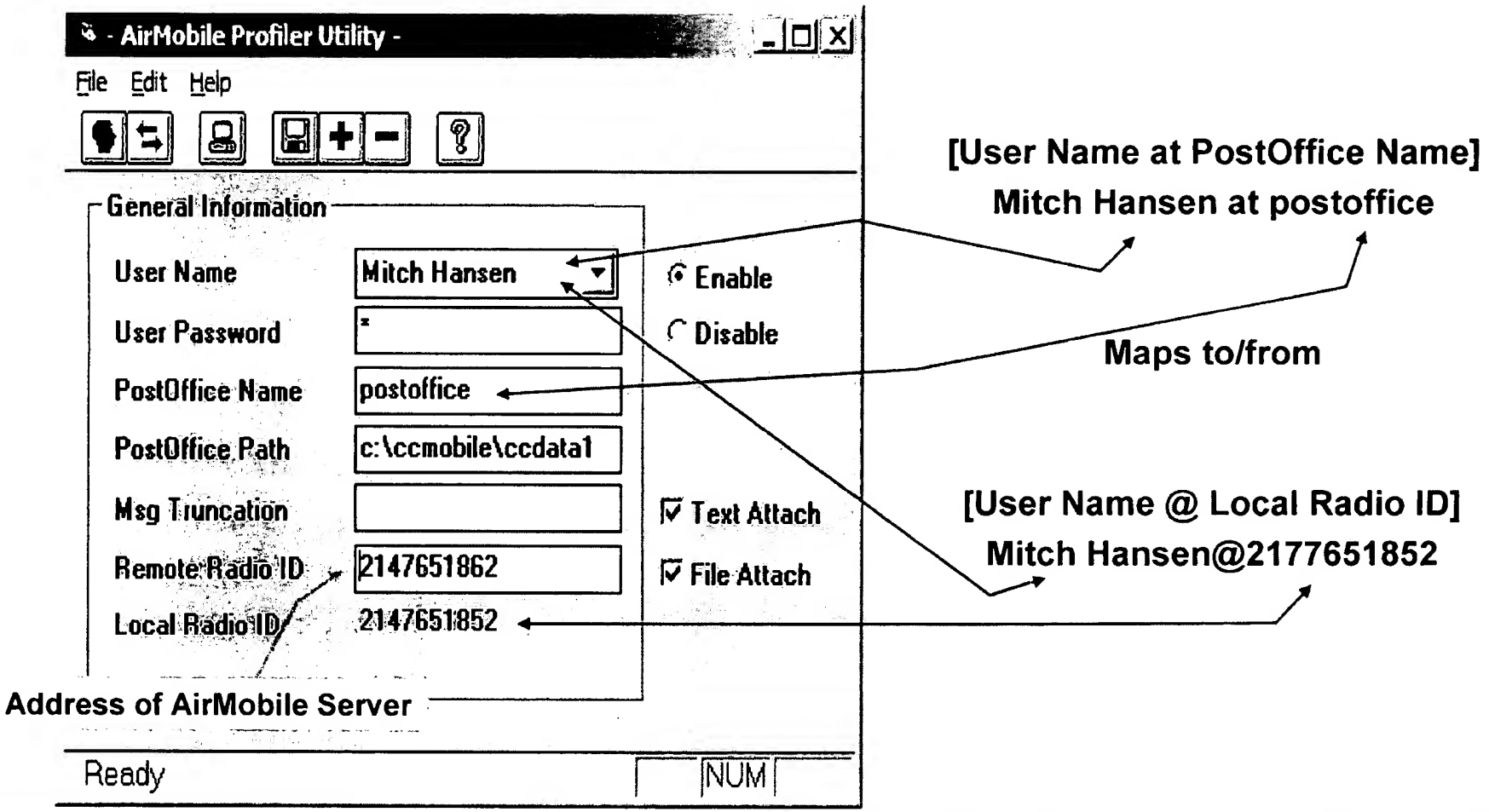
*** RECEIVE STARTED ***
From: Mitch Hansen@2147651852;
To: Gene Eggleston@2147651862;
Subject: Re: Important Meeting;
Type: ccMail Msg; MsgID 1902;

*** RECEIVE COMPLETED ***
From: Mitch Hansen@2147651852;
To: Gene Eggleston@2147651862;
Subject: Re: Important Meeting;
Type: ccMail Msg; MsgID 1902;

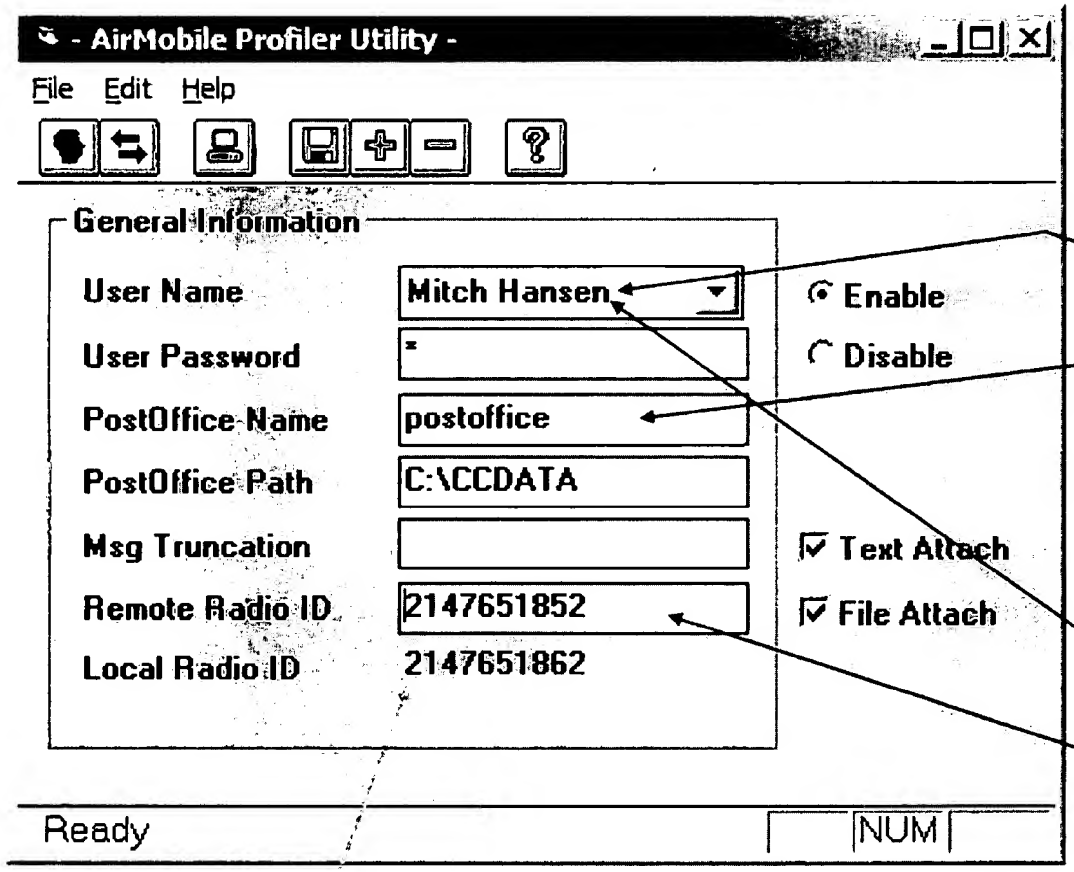
Mitch's reply message as received by Gene



AirMobile Client



AirMobile Server



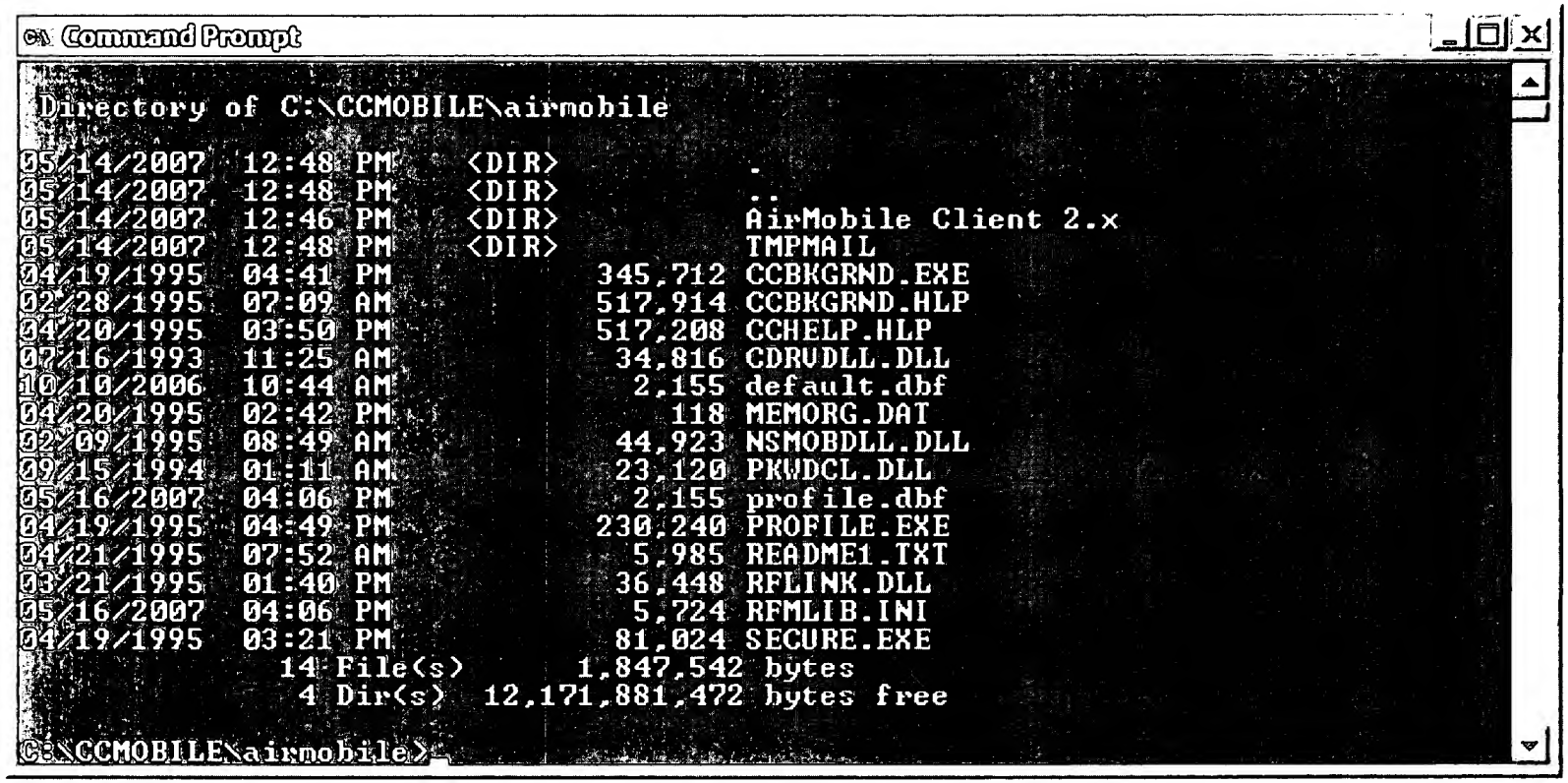
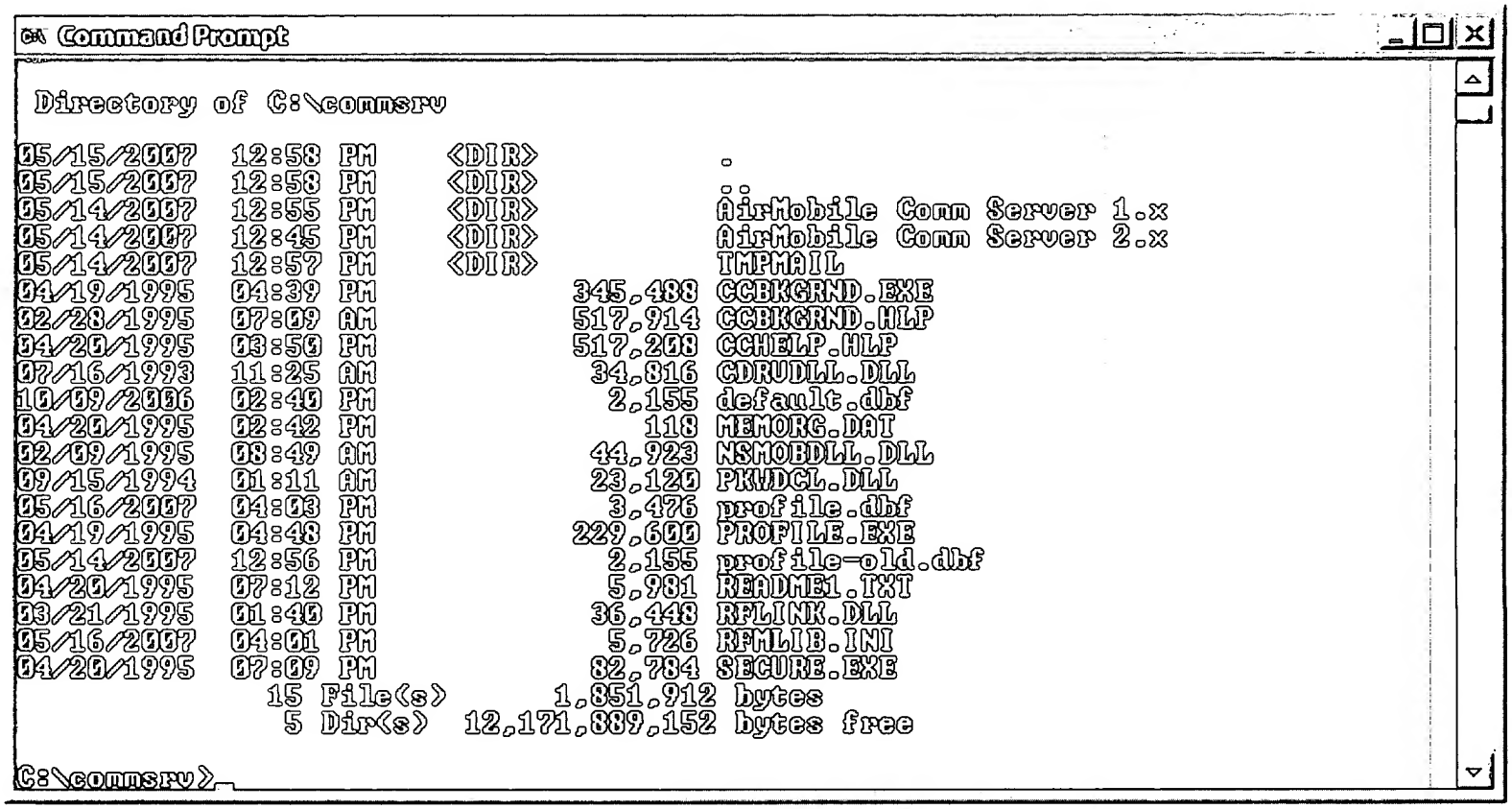
[User Name at PostOffice Name]
Mitch Hansen at postoffice

Maps to/from

[User Name @ Remote Radio ID]
Mitch Hansen@2147651852

Address of AirMobile Server
(same as the Remote Radio ID (e.g. 2147651862) shown in AirMobile Client)

AirMobile Client Software Directory File List



AirMobile Comm Server Software Directory File List